

REMARKS

Claims 44-57, 59-63, 65-84, 86-131 are pending in the Application and all stand rejected in the final Office action mailed June 9, 2011. Claims 53, 92, 95, 96, 98, 116, 122, and 128 are amended. Claims 44, 63, and 71 are independent claims from which claims 45-62, 90-92, and 114-119, claims 64-70, 93-95, and 120-125, and claims 72-89, 96-98, and 126-131 depend, respectively. Applicants respectfully request reconsideration of pending claims 44-57, 59-63, 65-84, and 86-131, in light of the remarks set forth below.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. §2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth "all reasons and bases" for rejecting the claims.

Rejections of Claims

Claims 44-57, 59-63, 65-84, and 86-131 stand rejected under 35 U.S.C. §112, first paragraph. Claims 44-57, 59-63, 65-84, and 86-131 stand rejected under 35 U.S.C. §112, second paragraph. Claims 44, 63, and 71 stand rejected under 35 U.S.C. 102(b) as being anticipated by US 4,723,238 ("Isreal").

Applicants respectfully note that the Office did not present rejections of claims 45-57, 59-62, 65-70, 72-84, and 86-131 under either 35 U.S.C. §102 or 35 U.S.C. §103, and that those claims are therefore allowable over the prior art.

Applicants respectfully traverse the rejections for the reasons set forth during prosecution, and those that follow.

I. Rejection Of Claims 44-57, 59-63, 65-84, And 86-131 35 U.S.C. §112, 1st ¶

Claims 44-57, 59-63, 65-84, and 86-131 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants respectfully traverse the rejection.

With regard to independent claims 44, 63, and 71, the Office rejects those claims at page 4 of the Office action stating, in part:

Claims 44, 63 and 71 recite coupling one of at least two communication networks to either a packet network of another of the at least two communication networks; however, the specification does not teach two communication networks in combination with a packet network. At most the specification teaches coupling one communication network with a packet network (**couple incoming call from telephone switching network 5605 with premises network 5503 over internal routing path, figs 55a, 56a and pgpub ¶¶622-625**). The specification teaches two networks, not three. Thus, the spec does not support the claim in a manner consistent with 112 1st. Dependent claims 45-57, 59-62, 65-70, 72-84 and 86-131 inherit this deficiency.

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Applicants respectfully disagree that the Specification does not support the claim in a manner consistent with 35 U.S.C. §112, first paragraph.

Applicants respectfully submit, as an example of support, Applicants' disclosure teaches an "access device 5507" that participates wirelessly as part of the wireless network of "premises 5501, which includes "access devices 5505, 5507, 5509, 5511 and 5513." *See, e.g.*, FIG. 55a, page 254, lines 16-17, page 288, lines 16-20. The "access device 5507" acts as a "host device" for the "computer card 5601." *Id.* at page 288, lines 16-17. The "computer card 5601" when installed in a "host device" handles "call setup and processing," and conversion between voice stream and voice packet forms, and behaves as described with respect to FIGs. 55a, 55b, and 56a. *Id.* at page 263, lines 1-7. As the Office seemingly recognizes, the functionality of the "computer card 5601" communicatively couples an incoming call from "switching input line 5605," with "backbone network 5503," over an "internal routing path." *See* Office action at page 4. Applicants respectfully submit that in the case of "access device 5507," the disclosure suggests that the functionality of "switching input line 5605" of the "computer card 5601" is connected to "telephone line 5539" (i.e., "one of at least two communication networks"), and that the "internal routing path" is the "wireless network" of "premises 5501". *Id.* at FIG. 55a. That is, as is described in the disclosure, the functionality of "computer card 5601" present in the "access device 5507" communicatively couples the "switching input line 5605" connected to "telephone line 5539," to the "wireless network" of "premises 5501."

Applicants' disclosure further teaches that the "wireless network" of "premises 5501" over which "access devices 5505, 5507, 5509, 5511 and 5513" communicate is a "packet network." *Id.* at pages 257, line 17 to page 258, line 15. Applicants' disclosure explains that "access device 5507" is communicatively coupled to "mobile terminals 5521, 5522, and 5523" over the packet "wireless network" of "premises 5501." *Id.* at page 288, line 18 to page 289, line 2. Therefore, Applicants respectfully submit that Applicants' disclosure teaches that the "wireless network" of "premises 5501," which communicatively couples "access device 5507" to "mobile terminal 5521," and to the "backbone network 5503" via "access device 5505," is a "packet network." Thus, Applicants respectfully submit that the functionality of "computer card 5601" in "access device 5507" communicatively couples "telephone line 5539" (i.e., "one of at least two

communication networks") to the "wireless network" of the "premises 5501" (i.e., a "packet network").

Applicants' disclosure also teaches that a dedicated "second transceiver" of "access device 5507" communicatively couples "access device 5507" to "wireless phone 5527" (i.e., "another of the at least two communication networks"). *Id.* at page 255, lines 8-11, page 263, lines 18-22.

Therefore, as demonstrated above, Applicants' disclosure does teach at least three networks, and does teach, at least, "communicatively coupling one of at least two communication networks, each having an associated information format, to either a packet network or another of the at least two communication networks," contrary to the assertions of the Office. Accordingly, Applicants respectfully request that the rejection of claims 44-57, 59-63, 65-84, and 86-131 under 35 U.S.C. §112, first paragraph, be reconsidered and withdrawn.

With regard to claims 116, 122, and 128, Applicants have amended claims 116, 122, and 128 as shown above, to address the concerns of the Examiner. Applicants submit that support for the amendments may be found at, for example, at page 284, line 3 to page 285, line 7 of the Specification. Applicants respectfully submit that no new matter is added. Applicants respectfully request that the rejection of claims 116, 122, and 128 under 35 U.S.C. §112, first paragraph be reconsidered and withdrawn.

With regard to claims 92, 95, and 98, Applicants have amended claims 92, 95, and 98 as shown above, to address the concerns of the Examiner. Applicants submit that support for the amendments may be found, for example, at page 283, line 3 to page 285, line 7 of the Specification. Applicants respectfully submit that no new matter is added. Applicants respectfully request that the rejection of claims 92, 95, and 98 under 35 U.S.C. §112, first paragraph be reconsidered and withdrawn.

II. Rejection Of Claims 44-57, 59-63, 65-84, And 86-131 Under 35 U.S.C. §112, 2nd ¶

Claims 44-57, 59-63, 65-84, and 86-131 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse the rejection.

With regard independent claims 44, 63, and 71, the Office rejects claims 44, 63, and 71 stating, in part, the following at page 3:

Claims 44, 63 and 71 substitute the amended "directions" with the previously recited "configuration information" and "call parameters". It is unclear how this affects the scope of the claims. The specification refers to the host device receiving dialed numbers and comparing them to a cross-reference database (**see pgpub at ¶598+**). It is vague as to whether applicant is now referring to something else. Dependent claims 45-57, 59-62, 65-70, 72-84 and 86-131 inherit this deficiency.

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Applicants respectfully submit that Applicants' amendments to claims 44, 63, and 71 are both clear and definite, and that there is nothing "vague" about the use of the word "directions." With respect to the use of this term, Applicants respectfully submit that Applicants' claim 63 recited that term prior to Applicants' amendments of April 7, 2011, to which the Office now rejects, and that the Office did not previously question the use of that term. Applicants respectfully submit that the amendments of April 7, 2011 simply made the wording of independent claims 44, 63, and 71 consistent, that the Applicants are not using the term in a manner inconsistent with the Specification or with respect to common ordinary usage, and that the use of the term "directions" is both clear and definite, and is supported, for example, at pages 271 to 289 of the Specification. Therefore, Applicants believe that claims 44, 63, and 71 are in compliance with 35 U.S.C. §112, second paragraph, and respectfully request that the Office reconsider and withdraw the rejection.

With regard dependent claim 96, Applicants have amended claim 96 as shown above, to correct a noted claim drafting error, which was recognized by the Examiner.

Applicants express appreciation to the Examiner for bringing this minor error to the attention of the Applicants. Applicants respectfully submit that the amendment to claim 96 does not add new matter.

III. Israel Does Not Anticipate Claims 44, 63, And, 71

Claims 44, 63, and 71 stand rejected under 35 U.S.C. §102(b) as being anticipated by US 4,723,238 ("Isreal"). Applicants respectfully traverse the rejection.

Applicants first review requirements for a rejection based upon anticipation.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). "The identical invention must be shown in as complete detail as is contained in ... the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Further, "[t]he elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required." MPEP § 2131 (citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); emphasis added).

Applicants respectfully submit that the Office has not met the requirements to establish a *prima facie* case of anticipation, for at least the reasons that follow.

With regard to independent claim 44, Applicants respectfully submit that claim 44 recites "[a] method of operating a device for communicatively coupling one of at least two communication networks, each having an associated information format, to either a packet network or another of the at least two communication networks, the method comprising: receiving, from the packet network or the one of at least two communication networks, information requesting setup of a call between the one of at least two communication networks and either the packet network or another of the at least two communication networks; providing, to a host device, at least a portion of the information requesting setup of a call; receiving, from the host device, directions based upon the at least a portion of the information requesting setup of a call; and

communicatively coupling the one of at least two communication networks to either the packet network or another of the at least two communication networks, according to the directions from the host device.” Independent claims 63 and 71 recite language similar to claim 44. Applicants respectfully submit that claims 44, 63, and 71 were rejected over the same art using the same rationale. See Office action at page 7. Applicants respectfully submit that Isreal does not teach each and every element of claim 44, and therefore does not render claim 44, or any of the claims that depend from claim 44, unpatentable.

For example, Applicants respectfully submit that claim 44 recites, in part, “[a] method of operating a device for communicatively coupling one of at least two communication networks, each having an associated information format, to either a packet network or another of the at least two communication networks, the method comprising: receiving, from the packet network or the one of at least two communication networks, information requesting setup of a call between the one of at least two communication networks and either the packet network or another of the at least two communication networks.” The rejection of claim 44 over Israel states, in part, the following:

For claim 44, Isreal teaches a method of operating a device for communicatively coupling one of at least two communication networks, each having an associated information format (**CSS 12 and port circuit 122-K to other CSS two communication networks**, fig. 1 and col. 2 lines 40-46. **Multiple PSS 13 systems**, col. 13 lines 1-13), to either a packet network (**PSS 13 'packet network'**, fig. 1 and col. 2 lines 52-63) or another of the at least two communication networks, the method comprising:

receiving, from the packet network or the one of at least two communication networks, information requesting setup of a call between the one of at least two communication networks and either the packet network or another of the at least two communication networks (**network interface card 14 receives call originating from packet terminal 131-X or circuit terminal 121-X or other circuit network 122-K**, fig. 1 and col. 3; **CSS-PSS call**, col. 3 lines 22-44 and col. 9 line 15; **CSS-CSS call**, col. 3 lines 45-54; and **PSS-CSS call**, col. 3 line 55 - col. 4 line 11 and col. 11 line 20);

(bold in original, underline added)

Thus, although not explicitly and specifically identifying the teaching of Isreal that corresponds to Applicants' "device for communicatively coupling...", the Office seemingly asserts that the "network interface controller 14" of Isreal allegedly teaches the "device for communicatively coupling..." element of Applicants' claim 44 that is to be "receiving, from the packet network or the one of at least two communication networks, information requesting setup of a call" **If this understanding is in error, Applicants respectfully request the Office to explicitly and specifically identify each of the elements of Applicants' claim 44 and the corresponding elements of Isreal alleged to disclose Applicants' claim features.** We now turn our attention to the next clause of claim 44, which recites "providing, to a host device, at least a portion of the information requesting setup of a call." The Office rejects this aspect of claim 44 stating, in part at page 6, the following:

providing, to a host device, at least a portion of the information requesting setup of a call (Terminal 121-1 dials a data call request to call processor (CP) 123. The CP 123 checks a terminal location table (201 of FIG. 2) to determine if the destination terminal 131-M is located in CSS 12 or PSS 13. Since destination terminal 131-M is located on PSS, CP 123 forwards the call request to NIC 14 'host device', col. 3 lines 24-30);

(bold in original, underline added))

However, although the Office first asserted that the "network interface card 14 receives call originating from packet terminal 131-X or circuit terminal 121-X", the portion of the rejection shown above teaches "Terminal 121-1 dials a data call request to call processor (CP) 123," which seems to be identifying the "call processor (CP) 123" as teaching Applicants' claimed "device for communicatively coupling ...," and to be identifying the "NIC 14" as teaching Applicants' claimed "host device." **If this understanding is in error, Applicants respectfully request the Office to explicitly and specifically identify each of the elements of Applicants' claim 44 and the corresponding elements of Isreal alleged to disclose Applicants' claim features.**

Applicants respectfully submit that the arguments rejecting these two aspects of claim 44, namely, "receiving, from the packet network..., information requesting setup of a call..." and "providing, to a host device, at least a portion of the information requesting setup of a call," reveal inconsistent interpretation of the teachings of the Isreal reference **that cannot support establishment of a *prima facie* case of anticipation.** Therefore, Applicants respectfully submit that claim 44 is allowable for at least this reason alone. Applicants respectfully submit that claim 44 is allowable for additional reasons.

Applicants now address the next clause of claim 44, which recites "receiving, from the host device, directions based upon the at least a portion of the information requesting setup of a call." The rejection of this aspect of claim 44 states the following:

receiving, from the host device, directions based upon the at least a portion of the information requesting setup of a call **(The NIC 14 acts like a terminal on PSS 13 and attempts to complete the data call to destination terminal 131-M. If the data call set-up on PSS 13 is successful, NIC 14 notifies CP 123 accordingly 'directions', col. 3 lines 30-33);**

(bold in original, underline added)

Here, the Office asserts that an alleged teaching by Isreal at col. 3, lines 30-33 of "NIC 14" notifying "CP 123" of a successful "data call setup" teaches the "NIC 14" providing "directions" to "CP 123." Applicants respectfully disagree. Applicants respectfully submit that a first person or thing notifying a second person or thing of something is not equivalent to the first person or thing directing the second person or thing. The words "notify" and "direct" are not interchangeable. The word "notify" may be defined as "1. To give notice to; inform." *See, e.g.*, The American Heritage Dictionary of the English Language, © 1979, Houghton Mifflin Company, page 897. The word "direct" may be defined as "1. To conduct the affairs of; manage; regulate. 2. To take charge of with authority; control." *See, e.g., id.* at page 373. To notify is to inform, to direct is to manage or control.

Therefore, Applicants respectfully submit that the "NIC 14" and "CP 123" of Isreal

do not teach Applicants' claimed "host device" and "device for communicatively coupling ...," respectively, and the cited portion of Isreal at col. 3, lines 30-33 does not teach, suggest, or disclose Applicants' claimed "device for communicatively coupling..." receiving directions from the claimed "host device." Applicants respectfully submit that because Isreal fails to teach at least this aspect of claim 44, Isreal fails to teach each and every element of claim 44, and fails to anticipate claim 44. Therefore, Applicants respectfully submit that claim 44 is allowable for at least this additional reason.

Applicants respectfully submit that claim 44 also recites "communicatively coupling the one of at least two communication networks to either the packet network or another of the at least two communication networks, according to the directions from the host device." The Office rejects this clause of claim 44 at page 7 of the Office action, stating:

communicatively coupling the one of at least two communication networks to either the packet network or another of the at least two communication networks, according to the directions from the host device **(The CP 123 then selects a data converter (e.g., 145D) for the call and sends an appropriate message back to the originating terminal 121-1. The data transmission path for the established data call includes originating terminal 121-1, port circuit 122-1, TDM bus 124, T/R 147, data bus 154, NPE 152, data converter 145D, NAU bus 146, CSMA interface controller 141, NAU 132-1 and destination terminal 131-M, col. 3 lines 33-41).**

(bold in original)

Initially, Applicants respectfully submit that an alleged teaching of "CP 123" selecting a "data converter" for the call and sending a message to the "originating terminal" is not a teaching of the "CP 123" communicatively coupling as in Applicants' "device for coupling..." as suggested by the Office. Further, there is no mention in the cited portion of Isreal that the "data converter" is selected "according to the directions from the host device," which the Office has identified as taught by "NIC 14," as required by claim 44. Notably, the "data transmission path" does not include the "CP 123," identified by the Office as teaching Applicant "device for coupling..."

Therefore, for at least these reasons, Applicants respectfully submit that the

Office has not demonstrated that Israel teaches at least the portion of claim 44 that recites "communicatively coupling the one of at least two communication networks to either the packet network or another of the at least two communication networks, according to the directions from the host device," has not shown that Israel teaches each and every element of claim 44, and therefore has not shown that Isreal anticipates claim 44.

With regard to independent claim 63 and 71, Applicants respectfully submit that independent claims 63 and 71 recite language similar to that of claim 44, and are rejected over the same art, using the same rationale set forth in rejecting claim 44. *See* Office action at page 7. Thus, Applicants respectfully submit that independent claims 63 and 71, and their respective dependent claims, are also allowable over Isreal.

Based at least upon the above, Applicants respectfully submit that the Office has not shown that Isreal teaches each and every element of claims 44, 63, and 71, as required by M.P.E.P. §2131, that Isreal does not anticipate claims 44, 63, and 71, and that claims 44, 63, and 71, and their respective dependent claims, are allowable over Isreal. Accordingly, Applicants respectfully request that the rejection of claims 44, 63, and 71 under 35 U.S.C. §102(b) be reconsidered and withdrawn.

IV. Claims 45-57, 59-62, 65-70, 72-84, and 86-131 Are Allowable Over The Prior Art

Applicants again respectfully note that the Office did not present rejections of claims 45-57, 59-62, 65-70, 72-84, and 86-131 under either 35 U.S.C. §102 or 35 U.S.C. §103, and are therefore allowable over prior art.

Conclusion

In general, the Office action makes various statements regarding the claims of the Application and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of the pending claims are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, or the Examiner has any suggestions to move the Application towards allowance, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000 to arrange an interview.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

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